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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,336	06/30/2000	Ken Miyagawa	11103-017001/PU01-0054	8326

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EXAMINER

SCHULTZ, WILLIAM C

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 07/26/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,336

Applicant(s)

MIYAGAWA ET AL.

Examiner

William C. Schultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings were received on 5/17/2004. These drawings are accepted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,6-9, are rejected under 35 U.S.C. 102(b) as being anticipated by Eriksson [U.S. Pat. 5,483,532].

Regarding claims 1,4,6,9, Eriksson discloses a block forming method whereby a digital bit stream consisting of a plurality of packets having a same length is converted into a data block and at least a main data portion in which a plurality of complete packets and partial packets consisting of only partial data can be arranged and an additional data portion in which additional data of each of said complete packets in said main data portion and additional data of one partial packet are stored are formed in said data block, comprising the steps of:

when a space area smaller than one packet occurs in an end portion of said main data portion,

storing a part of the data of a next packet into said space area, (**fig.1**)

storing additional data of said next packet into said additional data portion as additional data of said one partial packet, and (**fig. 2**)

storing remaining data of the part of the data of said next packet into a start portion of the main data portion of a next data block; and **(fig. 2, col. 4, lines 1-45)** when said space area does not occur in the end portion of said main data portion,

storing additional data invalid information showing that the additional data of said one partial packet is invalid into a portion other than said main data portion in said data block.**(fig. 2, part discontinuous data field)**

Further regarding claims 6,9, Eriksson discloses discriminating means. **(col. 3, lines 1-67)**

Regarding claims 2,7, Eriksson further discloses said additional data invalid information is a flag which is arranged in a portion other than said main data portion and said additional data portion in said data block. **(fig. 2)**

Regarding claims 3,8, Eriksson further discloses said additional data invalid information is a flag which is arranged in said additional data portion in said data block. **(fig. 2)**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eriksson [U.S. Pat. 5,483,532] as applied to claims 4,9 above, and further in view of Peterson et al. [U.S. Pat. 6,504,845].

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Eriksson discloses as above but fails to disclose the padding is with zeroes.

Peterson et al. discloses padding an ATM cell is done with zeroes.

It would have been totally obvious to one of ordinary skill in the art to modify Eriksson with Peterson et al. The motivation to pad with zeroes is to fill the fixed transmission frame up to the transmission frame limit because it is a requirement of that the frame be of a certain size.

Election/Restrictions

Newly submitted claims 11-18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Group I, claims 11-13,18 are drawn to an information recording medium to which data is recorded onto.

Group II, claims 14-17 are drawn to an playing an information recording medium which has data recorded on it.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, Group I has separate utility such as complete and partial packets being recorded onto the medium; Group II has separate utility such as a discriminator for performing error checking before playback occurs.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-18 are **withdrawn** from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Applicant's arguments filed 5/10/2004 have been fully considered but they are not persuasive.

1) “Eriksson does not teach or suggest the provision of additional data regarding packets in a main data portion as discussed and claimed ...”

This is just a general allegation that the prior art does not meet the limitations which does not comply with 37 CFR 1.111(b).

2) “Eriksson does not teach or suggest forming an additional data portion ... ”

The discontinuous fields do correspond to an additional data portion. From Eriksson, in the preferred embodiment section, “Packet data are put into the packet fields PF which have been reserved in the fixed frame. ... such packets, from a packet network are marked with pointers ... these pointers will use a number of n bits determined by properties of the source.” (**col. 2, lines 55-62**) Further on column 3, “as a first example, fig.1 shows a portion of a frame produced according to the invention. ... packet fields PF1, PF2, PF3 reserved for data from packet

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networks[sp] ... the packet DP2 starts, as can be seen, in PF3 and continues in one or several packet fields, not shown” This illustrates the spanning of a packet. Further more looking figure 2, shown is DP2 ending in the middle of PF3 and DP3 starting at some point in the remaining bits of PF3. This clearly meets the limitations as set forth in the independent claims, from claim 1, “... space smaller than one packet occurs at the end portion of said main data portion, storing a part of the data of a next packet into said space area, storing additional data of said next packet into said additional data portion...” the spanning has to be taken from fig.1’s description where not shown subject matter is disclosed , that is that DP3 is continued into more PF fields like fig.1 disclosed though not shown. Also, when the claim says that invalid data is stored, it is more than reasonable to interpret empty spaces as invalid, one of ordinary skill in the art would easily conclude that from the reference.

3) “... 103(a) should be withdrawn because Eriksson and Peterson, singly or in combination, do not teach or suggest each feature ...”

This is just a general allegation that the prior art does not meet the limitations which does not comply with 37 CFR 1.111(b). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). MPEP 2145.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Schultz whose telephone number is 703-305-2367. The examiner can normally be reached on M-F(7-4)(first bi-week) M-Th(7-4)(second bi-week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 703-305-4366. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

William Schultz
November 17, 2003



WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER
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